

REMARKS/ARGUMENTS

The present application includes pending claims 27-64, all of which have been rejected. Claims 27, 40, 53 and 55 are independent claims. Claims 28-39, 41-52, 54 and 56-64 depend from independent claims 27, 40, 53 and 55. Claims 27, 40, 53 and 55 have been amended.

Initially, the Applicant notes that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review* of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel *should* state *all* reasons and bases for rejecting claims in the *first* Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

See Manual of Patent Examining Procedure (MPEP) § 2106(II). As such, the Applicant assumes, based on the goals of patent examination noted above, that the present Final Office Action has set forth "all reasons and bases" for rejecting the claims.

Claims 27-64 stand rejected under 35 U.S.C. § 103(a). In this regard, claims 27-34, 37, 38, 53, and 55-64 are rejected under § 103(a) for allegedly being unpatentable over Chen (WO Patent Publication No. 2004/016037; hereinafter "Chen,") in view of Gollmar et al. (U.S. Patent No. 4,901,354; hereinafter "Gollmar,") Claim 35 is rejected under § 103(a) for allegedly being unpatentable over Chen, in view of Gollmar, and further in view of Butler et al. (U.S. Patent No. 6,474,816; hereinafter "Butler,") Claim 36 is rejected under § 103(a) for allegedly being unpatentable over Chen, in view of Gollmar and Butler, and further in view of Nestorovic et al. (U.S. Patent Application Publication No. 2004/0155186; hereinafter "Nestorovic,") Claims 39-47 and 50-52 is

rejected under § 103(a) for allegedly being unpatentable over Chen, in view of Gollmar, and further in view of Warren et al. (U.S. Patent No. 7,013,009; hereinafter "Warren.") Claim 48 is rejected under § 103(a) for allegedly being unpatentable over Chen, in view of Gollmar, Butler, and Warren. Claim 49 is rejected under § 103(a) for allegedly being unpatentable over Chen, in view of Gollmar, Butler, Warren, and Nestorovic. Claim 54 is rejected under § 103(a) for allegedly being unpatentable over Chen, in view of Gollmar, and further in view of Addeo et al. (U.S. Patent No. 5,335,011; hereinafter "Addeo.")

The Applicant respectfully traverses these rejections at least based on the following remarks. In addition, the Applicant also reserves the right to argue additional reasons beyond those set forth herein to support allowability of the claims, should a need arise in the future.

APPLICANT'S COMMENTS

The Applicant initially notes the Examiner's assertions that various official notices taken by the Examiner in the previous office action of September 30, 2011 (hereinafter "Prior OA") are now considered "admitted prior art" because the Applicant allegedly failed to challenge these official notices. See Final Office Action, at pp. 4 and 7-8. The Applicant respectfully disagrees with the Examiner, and submits that the Examiner's official notices do not constitute "admitted prior art" as alleged by the Examiner. In this regard, the Applicant submits that while the Applicant did not expressly address in the response to the Prior OA, which was filed on December 15, 2012 (hereinafter, the "Prior Response,") the official notices taken by the Examiner in the Prior OA and/or the Examiner's arguments based thereon, these official notices have not become "admitted prior art" because the Applicant expressly reserved "the right to argue additional reasons beyond those set forth ... to support the allowability" of claims 37-38, 50, and 63-64, to which the official notices pertain. See Prior OA, at pp. 5 and 8, and Prior Response, at pp. 15 and 18. In other words, reserving the right to argue "additional reasons" for supporting the allowability of these claims would reasonably include

reserving the right to challenge and expressly address the official notices and the Examiner's arguments based thereon, and as such would prevent these official notices from becoming "admitted prior art" as asserted by the Examiner.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

The Applicant turns to the claim rejections under 35 U.S.C. § 103(a) based on various combinations of Chen, Gollmar, Butler, Nestorovic, Warren, and Addeo. Without conceding that any of Chen, Gollmar, Butler, Nestorovic, Warren, and Addeo would qualify as prior art; or that any combination thereof is valid for purposes of 35 U.S.C. § 103(a), the Applicant respectfully traverses these rejections.

Initially, the Applicant notes that the determination of obviousness is a legal conclusion based on underlying findings fact. *Sanofi-Synthelabo v. Apotex, Inc.*, 550 F.3d 1075, 1085 (Fed. Cir. 2008). The factual inquiries include: (1) the scope and content of the prior art, (2) the differences between the prior art and the claims, (3) the level of ordinary skill in the relevant art, and (4) any objective indicia of non-obviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 86 S.Ct. 684 (1966). Initially, the burden is on the Examiner to establish a *prima facie* case of obviousness. See MPEP at § 2142. "If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." See *id.*

"The determination of obviousness is made with respect to the subject matter as a whole, not separate pieces of the claim." *Apotex*, 550 F.3d 1075 at 1086. (citing *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007); *Kimberly-Clark Corp. v. Johnson & Johnson*, 745 F.2d 1437, 1448 (Fed.Cir.1984)). Accordingly, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." See MPEP § 2143.03 (quoting *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970)). If, considering the claim as a whole, the Examiner deems the claim to be obvious in view of the prior art, the Examiner must provide a "clear articulation of the reason(s) why the claimed invention would have been obvious." See MPEP § 2142. The Examiner's

determination of obviousness “cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. 398 at 418 (quoting *In re Kahn*, 441 F.3d 977, 988, (Fed. Cir. 2006)).

In reviewing an Examiner’s determination of obviousness, “the Board cannot simply reach conclusions based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.” *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). *See also In re Vaidyanathan*, Appeal 2009-1404 at 18-19 (Fed. Cir. May 19, 2010) (nonprecedential) (“If the examiner is able to render a claim obvious simply by saying it is so, neither the Board nor [the Federal Circuit] is capable of reviewing that determination. ... If there is neither record evidence nor detailed examiner reasoning, the Board should not conclude that [the Appellant’s] claims are obvious.”)

With those principles in mind, the Applicant now turns to the claim rejections.

I. Rejection of Independent Claims 27, 40, 53 and 55

a. *Rejection of Independent Claims 27, 53 and 55*

With regard to the rejection of the independent claims 27, 53 and 55 under 35 U.S.C. § 103(a) for allegedly being unpatentable over the combination of Chen and Gollmar, the Applicant submits that claim 1 has been amended such that the amended claim 27 now recites: “an eyeglass frame having a plurality of directionally dependent microphones to capture one or more voice signals; a transmitter configured to transmit *data comprising* said one or more captured voice signals to one or more external electronic devices; *a display module configured to display video data in accordance with a user’s direction of view*; and a control module configured to adjust directional dependence of at least a first directionally dependent microphone of said plurality of directionally dependent microphones based on said one or more voice signals captured

by said first directionally dependent microphone and at least a second directionally dependent microphone of said plurality of directionally dependent microphones, wherein said second directionally dependent microphone is located on an ear engaging portion of said eyeglass frame for capturing bodily vibration sound waves." (Emphasis added). The Application notes that claims 53 and 55 have also been amended to incorporate similar changes. Accordingly, the Applicant submits that the combination of Chen and Gollmar does not teach or disclose all the limitations of amended claims 27, 53 and 55.

Specifically, the application submits that Chen and Gollmar do not teach or suggest, individually or in combination that the eyeglass frames disclosed thereby *"display video data in accordance with a user's direction of view,"* as recited by the Applicant amended claims 27, 53 and 55. In this regard, the Applicant notes that Chen does not teach or suggest that the spectacles described by provide or incorporate any displaying function, or that it is used in displaying any images or video data. Rather, the only display element described by Chen is LCD display (25) of the external signal processing device (10). Similarly, the Applicant notes that Gollmar does not disclose any eyeglasses, nor does Gollmar teach or suggest any displaying function for use in conjunction with the operations described thereby, or any images or video data or displaying thereof.

Accordingly, the Applicant believes that the Applicant's claims 27, 53 and 55 are not unpatentable over the combination of Chen and Gollmar, and that claims 27, 53 and 55 should be allowed. Therefore, the Applicant respectfully requests that the rejection of claims 27, 53 and 55 under 35 U.S.C. § 103(a) be withdrawn. The Applicant also reserves the right to argue additional reasons beyond those set forth herein to support the allowability of the independent claims 27, 53 and 55 should such a need arise.

b. Rejection of Independent Claim 40

With regard to the rejection of the independent claim 40 under 35 U.S.C. § 103(a) for allegedly being unpatentable over the combination of Chen, Gollmar and

Warren, the Applicant submits that claim 40 has been amended such that the amended claim 40 now recites: "capturing one or more voice signals via a plurality of directionally dependent microphones; transmitting *data comprising* said one or more captured voice signals to one or more external devices; *displaying video data in accordance with a user's direction of view*; and adjusting, via a control module, directional dependence of at least a first directionally dependent microphone of said plurality of directionally dependent microphones based on said one or more voice signals captured by said first directionally dependent microphone and at least a second directionally dependent microphone of said plurality of directionally dependent microphones; wherein said second directionally dependent microphone is positioned for capturing bodily vibration sound waves." (Emphasis added).

Specifically, the application submits that Chen, Gollmar and Warren do not teach or suggest, individually or in combination that the eyeglass frames disclosed thereby "*display video data in accordance with a user's direction of view*," as recited by the Applicant amended claim 40. In this regard, the Applicant reiterates the neither Chen nor Gollmar disclose any display function, or any handling or displaying of any images or video data. *See supra*. Furthermore, the Applicant notes that Warren does not teach or suggest that the eyeglasses (10) described by provide or incorporate any displaying function, or that it is used in displaying any images or video data during the audio related operations performed thereby.

Accordingly, the Applicant believes that the Applicant's claim 40 is not unpatentable over the combination of Chen, Gollmar and Warren, and that claim 40 should be allowed. Therefore, the Applicant respectfully requests that the rejection of claim 40 under 35 U.S.C. § 103(a) be withdrawn. The Applicant also reserves the right to argue additional reasons beyond those set forth herein to support the allowability of the independent claim 40 should such a need arise.

II. Rejection of Claims 28-34, 37, 38 and 56-64

Based on at least the foregoing, the Applicant believes the rejection of independent claims 27 and 55 under 35 U.S.C. § 103(a) for being unpatentable over the combination of Chen and Gollmar has been overcome. Accordingly, and because claims 28-34, 37, 38 and 56-64 depend from independent claims 27 and 55, respectively, they are, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to the rejection of claims 27 and 55 under 35 U.S.C. § 103(a).

The Applicant also reserves the right to argue additional reasons beyond those set forth herein to support the allowability of the claims 28-34, 37, 38 and 56-64 should such a need arise.

III. Rejection of Claims 41-47 and 50-52

Based on at least the foregoing, the Applicant believes the rejection of independent claim 40 under 35 U.S.C. § 103(a) for being unpatentable over the combination of Chen, Gollmar and Warren has been overcome. Accordingly, and because claims 41-47 and 50-52 depend from independent claim 40, respectively, they are, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to the rejection of claim 40 under 35 U.S.C. § 103(a).

The Applicant also reserves the right to argue additional reasons beyond those set forth herein to support the allowability of the claims 41-47 and 50-52 should such a need arise.

IV. Rejection of Claims 35, 36, 39 and 54

Based on at least the foregoing, the Applicant believes the rejection of independent claims 27, 53 and 55 under 35 U.S.C. § 103(a) for allegedly being unpatentable over the combination of Chen and Gollmar has been overcome. In

rejecting claims 35, 36, 39 and 54, the Examiner cites in addition to the combination of Chen and Gollmar, one or more of Butler, Nestorovic, Warren, and Addeo. *See* Final Office Action, at pp. 5-6 and 9. However, because the Examiner does not assert any additional grounds and/or make any additional arguments for rejecting claims 27, 53 and 55 based on Butler, Nestorovic, Warren, and/or Addeo, and because claims 35, 36, 39 and 54 depend from independent claims 27, 53 and 55, they are, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to the rejection of claims 27, 53 and 55 under 35 U.S.C. § 103(a).

The Applicant also reserves the right to argue additional reasons beyond those set forth herein to support the allowability of the claims 35, 36, 39 and 54 should such a need arise.

V. Rejection of Claims 48 and 49

Based on at least the foregoing, the Applicant believes the rejection of independent claim 40 under 35 U.S.C. § 103(a) for allegedly being unpatentable over the combination of Chen, Gollmar and Warren has been overcome. In rejecting claims 48 and 49, the Examiner cites in addition to the combination of Chen, Gollmar and Warren, one or more of Butler and Nestorovic. *See* Final Office Action, at pp. 8-9. However, because the Examiner does not assert any additional grounds and/or make any additional arguments for rejecting claim 40 based on Butler and/or Nestorovic, and because claims 48 and 49 depend from independent claim 40, they are, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to the rejection of claim 40 under 35 U.S.C. § 103(a).

The Applicant also reserves the right to argue additional reasons beyond those set forth herein to support the allowability of the claims 48 and 49 should such a need arise.

In general, the Final Office Action makes various statements regarding claims 27-64 and the cited references that are now moot in light of the above. Thus, the Applicant will not address such statements at the present time. However, the Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

CONCLUSION

Based on at least the foregoing, the Applicant believes that claims 27-64 are in condition for allowance. If the Examiner has any questions or the Applicant can be of any assistance, the Examiner is invited to contact the undersigned attorney.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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